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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,915	07/31/2006	Jordi Tormo I Blasco	5000-0186PUS1	3592

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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KLINKEL, KORTNEY L

ART UNIT	PAPER NUMBER
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1615

NOTIFICATION DATE	DELIVERY MODE
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08/05/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/587,915	BLASCO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kortney Klinkel	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/31/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claims***

Claims 1-10 are pending in the instant Office action.

### ***Information Disclosure Statement***

Acknowledgement is made of applicant's submitting an information disclosure statement on November 21, 2005. EP 0276666, DE 1193498 were not in English and therefore were not considered. The two JP documents were not submitted and therefore were not considered. With these exceptions, the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

### ***Foreign Priority***

Acknowledgement is made of applicant's foreign priority claims to German patent applications 10 2004 009 941.3, filed February 26, 2004. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Dependent claims 4 and 5 recite the limitation the compound I and the compound II or the compounds I and II. There is insufficient antecedent basis for this limitation in the claims. This rejection can be overcome by inserting the words "of formula" between compound and the Roman numeral I or II.

Dependent claims 5 recites the limitation "applied simultaneously, that is jointly or separately, or in succession". Claim 5 is internally inconsistent because its parent claim, claim 1, indicates that compounds of formula I and II are in admixture. A mixture does not allow for separate or successive application of ingredients contained therein. There is insufficient antecedent basis for this limitation in the claims.

Claim 10 provides for the use of the compounds I and II, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 10 provides for the use of the compounds I and II...for preparing a composition suitable for controlling harmful fungi, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pees (US 6117876).

Applicants claim a fungicidal mixture which comprises a triazolopyrimidine derivative of formula I and dichlofluanid of the formula II, in a synergistically effective amount.

Pees et al. teach the triazolopyrimidine of instant formula I (see column 4, lines 12-19, more specifically lines 58-59 and Example 2) which have enhanced systemic activity and enhanced fungicitoxy against rice diseases (column 4 lines 30-45), namely for the control of phytopathogenic fungi such as *Altemaria solani*, *Botrytis cinerea*, *Cercospora beticola*, *Cladosporium herbarum*, *Corticium rolfsfi*, *Erysiphe grarninis*, *Helminthosporium tritici repentis*, *Leptosphaeria nodorum*, *Micronectriella nivalis*, *Monilinia fructigena*, *Mycosphaerella ligulicola*, *Mycosphaereila pinodes*, *Pyricularia*

*grisea f. sp. oryzae*, *Rhizoctonia solani* and *Sclerotinia sclerotiorum*, *Uncinula necator*, in particular for the control of *Uncinula necator*.

Pees further teaches that the triazolopyrimidine compounds (including the instant compound of the formula I) can be mixed with other fungicides which “can have a broader spectrum of activity than the compound of general formula I alone. Furthermore, the other fungicide can have a synergistic effect on the fungicidal activities of the compound of general formula I.” (column 10 lines 57-61). Examples of the other such fungicides include dichlofluanid (the fungicide of instant formula II, please see column 11 line 2).

With respect to instant claim 3, which requires a fungicidal composition comprising a liquid or solid carrier, Pees teaches a liquid or solid carrier for the fungicidal mixtures (column 7, lines 60-67).

With respect to instant claim 4, which recites a method for controlling harmful fungi which are rice pathogens, which comprises treating the fungi at a specific locus including their habitat or the plants, the soil or the seeds, with the claimed fungicidal mixture, Pees teaches a method of treating the above mentioned rice pathogens by treating the locus, for example, plants, the fungi or seeds with a composition comprising the triazolopyrimidine (column 11, lines 53-58).

With respect to claims 6, 8 and 9 which specify the amount of the mixture to be applied per area or seed, Pees teaches a wide range of active agent(s) concentrations ranging from 0.05 to 100.00 mg/ml (column 7, lines 57-59). Pees is silent as to the amount applied per area per se, however the solutions were administered. With respect

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to the above optimization of ranges, “where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). The optimization of ranges does not support patentability absent evidence indicating such a range is critical. See also *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 “The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.”

The teachings of Pees differ from the instant invention in that Pees does not explicitly teach the combination of the triazolopyrimidine with dichlofluanid, but rather suggests the possibility of this combination from a *finite* list. However, it would have been obvious to use dichlofluanid in combination with the instant triazolopyrimidine to one of ordinary skill in the art at the time of the instant invention with a reasonable expectation of success because dichlofluanid is listed with a finite number of identified, predictable solutions.

Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR v. Teleflex*, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” *Id.* at 1742.

Consistent with this reasoning, it would have obvious to have selected



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dichlofluanid from the finite list of additional active agents, to arrive at the compositions of the instant invention with a reasonable expectation of success.

Applicant's data in the specification has been considered. Because Pees teaches synergistic effects with triazolopyrimidines, including the triazolopyrimidine of the instant invention, in combination with a number of other known fungicides, there is a high expectation of synergy in the instant claimed combination. It could be reasonably argued that in most cases, additive or better than additive results should be expected for the combination of such fungicides to one of ordinary skill in the art. For the reason outlined above, claims 1-10 are deemed *prima facie* obvious in light of the teachings of the prior art and rejection under 35 U.S.C. § 103 is appropriate.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

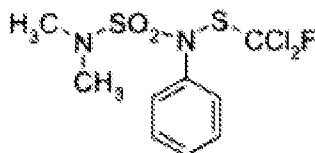
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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

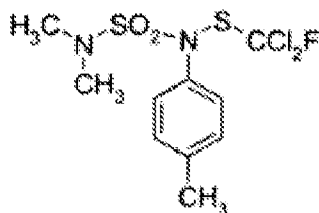
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/589877 (referred to hereafter as copending '877). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims a fungicidal mixture for controlling harmful fungi, which mixture comprises a triazolopyrimidine derivative and dichlofluanid of the following structure:



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Copending '877 claims a fungicidal mixture for controlling harmful fungi, which mixture comprises the same triazolopyrimidine derivative and tolylfluanid of the following structure:



The only difference between the two fluanid compounds is the presence of a methyl group in the 4-position. Hydrogen and methyl are obvious variants. See *In re Wood* 199 USPQ 137 (C.C.P.A. 1978), in which hydrogen and methyl are deemed obvious variants.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Conclusion**

Claims 1-10 are rejected. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kortney Klinkel, Ph.D. whose telephone number is (571)270-5239. The examiner can normally be reached on Monday-Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached at (571)272-8373. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KLK

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615